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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
04995/121001	

Application Number	Filed
10/688,558-Conf. #1170	October 16, 2003

First Named Inventor	
Hideaki Funakoshi et al.	

Art Unit	Examiner
2621	J. J. Vent

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 33,986
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____

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April 26, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hideaki Funakoshi et al.

Application No.: 10/688,558 Confirmation No.: 1170

Filed: October, 16, 2003 Art Unit: 2621

For: REPRODUCING APPARATUS AND REPRODUCTING METHOD OF DIGITAL VIDEO INFORMATION Examiner: J. J. Vent

MS: AFTER FINAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-11 are pending in the application and stand rejected under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent No. 5,787,225 (hereinafter "Honjo") in view of U.S. Patent No. 6,925,042 (hereinafter "Nakajo") further in view of U.S. Patent No. 6,961,510 (hereinafter "Proidl"). The Applicant respectfully asserts that the Examiner has failed to satisfy the requirements set forth in MPEP § 2143. Specifically, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations (*see* MPEP § 2143).

Independent claim 1 recites, in part:

> a control unit configured to control the expansion unit, when the high speed reproduction key is operated, to reproduce the compressed video and audio data for a number of frames corresponding to the n-fold speed, alternating with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames.

Independent claim 6 recites, in part:

> controlling the expanding, when a high speed reproduction for reproducing the compressed video and audio data in n-fold (where $n \geq 3$) speed is selected, to reproduce the compressed video and audio data for a number of frames corresponding to the n-fold speed, alternating with reproducing the compressed video and audio data in one of normal speed and two-fold speed for a predetermined number of frames;

A. <u>The Examiner is erroneously equating the claimed control unit/method with the control unit of Honjo.</u>

The Applicant has previously pointed out that Honjo shows operation of an optical disk player either at a normal-speed reproduction or at a high-speed reproduction (but not alternating between both of these speeds during reproduction). However, the Examiner continues to rely on column 6, lines 10-35 of Honjo and allege that a control unit of Honjo corresponds to a control unit/method required by claims 1 and 6 (*see* Office Action dated January 26, 2007, at page 3).

However, column 6, lines 10-35 of Honjo simply shows that the control unit 8 increases the rotation speed of the optical disk 1 by controlling a motor driving circuit 9 based on a received signals for high-speed reproduction (*see* Honjo, column 3, line 64 – column 4, line 2). That is, Honjo merely shows that the control unit 8 increases the rotation speed of the optical disk in the high-speed reproduction. Thus, the control unit 8 of Honjo is completely different from the control unit/method of the claimed invention.

Further, the apparatus of Honjo reproduces signals at the normal speed and at the high-speed *separately*. In fact, Honjo states, "[i]n a reproduction at the normal speed, the read-out video data is all decoded and output as the reproduced video signals," and "[i]n the high-speed reproduction, among the read-out video data, only the intra-coded video data and the forward predictive coded video data are output as the reproduced video signals" (*see* Honjo, column 2,

lines 27-32). Therefore, Honjo does not show or suggest the feature, during the high-speed reproduction of, "alternating with reproducing the data in one of normal speed and two-folded speed for a predetermined number of frames," as required by independent claims 1 and 6.

Accordingly, Honjo is completely silent with respect to this aspect of the claimed invention. Thus, in making this rejection, the Examiner is either reading out an express limitation of the claims or misinterpreting the teachings of the Honjo reference. Simply put, Honjo is devoid of any teaching or suggestion of this limitation.

B. Nakajo fails to show or suggest the claimed control unit.

As explained in the previous response dated October 26, 2006, in contrast to the claimed invention, Nakajo shows a high-speed recording system. Nakajo is completely silent with respect to high-speed reproduction, as required by the claimed invention. It would be clear to one skilled in the art that reproduction of a recorded medium is an operation that occurs separately from and independent of the recording of the medium, and that the recording operation disclosed by Nakajo is separate and distinct from high speed reproduction of previously recorded video and audio data, as required by the claimed invention. The purported reproduction, cited by the Examiner as column 2, lines 55+ of Nakajo (*see* Office Action dated January 26, 2007, at page 4), is in fact simply a linear velocity multiplication factor for recording a disk, which is calculated dependent on a directed number of rotations for the constant angular velocity control and the time information detected by ATIP detection circuit 32 (*see* Nakajo, column 13, lines 29-34). Thus, the teachings of Nakajo are inapposite to the claimed invention.

C. Proidl fails to show or suggest the claimed control unit.

In contrast to claimed invention, Proidl also does not show or suggest the feature of "alternating with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames," as required by independent claims 1 and 6. Reproduction device 1 of Proidl simply chooses one speed for reproducing, according to a recording speed during the recordation of the reproduction data on the tape (*see* Proidl, Abstract). Specifically, Proidl shows that an automatic change-over to the second trick-play reproduction speed occurs if no valid first-trick play reproduction is reproduced during a test interval. Then, if no valid second trick-play reproduction data is reproduced during a further test interval, an automatic change-over to the third trick-play reproduction speed occurs (*see* Proidl, column 2, lines 22-31). That is, Proidl reproduces data at each speed according to the recorded speed. Thus, Proidl does not show or suggest, during high-speed reproduction, "alternating with reproducing the data in one of normal speed and two-folded speed for a predetermined number of frames," as required by independent claims 1 and 6.

D. A person skilled in the art would not have been motivated to modify the teachings of Honjo, Nakajo and/or Proidl to achieve the claimed invention.

As noted above, none of Honjo, Nakajo and Proidl shows or suggests the limitation, "alternating with reproducing the data in one of normal speed and two-folded speed for a predetermined number of frames." Therefore, the combination of these three references also fails to provide the requisite teachings. Moreover, there is no teaching or suggestion in the art of record, and the examiner has provided no convincing line of reasoning, that would lead a person skilled in the art to modify the teachings of one or more of those references to reach the claimed invention, without the benefit of Applicant's own claims as a guide. Not only is such teaching or

motivation plainly lacking, but to make such a modification would fundamentally change the principle of operation of Honjo, Nakajo and Proidl. Honjo reproduces signals at a normal speed and at high-speed reproduction separately; Proidl reproduces data at each speed according to the speed recorded; and, Nakajo is a recording system. In each case, the principle of operation is inconsistent with the invention claimed.

E. The Examiner has failed to satisfy the requirements set forth in MPEP § 2143.

In view of the above, Applicant respectfully submits that the Examiner has failed to satisfy the requirements set forth in MPEP § 2143 with respect to independent claims 1 and 6. The remaining claims depend, directly or indirectly, from independent claims 1 and 6. Accordingly, the dependent claims are patentable for at least the same reasons. Accordingly, reversal of the rejection under §103 is respectfully requested.

Dated: April 26, 2007

Respectfully submitted,

By: _____

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